

## **REMARKS**

### **I. OVERVIEW**

Claims 1–10 are pending in this application. Claims 1–10 are amended to clarify what is claimed, and to place the claims in better form for U.S. prosecution. New claims 11–17 are added. Applicants submit that no new matter is added as support for the amended and new claims exists in the specification and claims as originally filed.

### **II. REJECTION UNDER 35 U.S.C. § 112 ¶ 2**

The Office Action has rejected claims 2–10 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action indicates that “claims 2–6 recite the language ‘such as’ and ‘preferably’, both of which render the claims indefinite.” Office Action at 3. Additionally, the Office Action indicates that claims 7–10 contain improperly multiple dependent claims. *Id.* Applicants have amended the claims as shown above and respectfully request withdrawal of this rejection.

### **III. REJECTIONS UNDER 35 U.S.C. § 102(B) AND 103(A) OVER COMERT**

The Office Action has rejected claims 1–10 under 35 U.S.C. §§ 102(b) and 103(a) as being unpatentable over U.S. Patent No. 5,250,607 to Comert *et al.* (“Comert”).

The present invention is generally directed to compositions obtained by mixing 100 parts by weight of an organic polymer (A) with moisture cross-linkable reactive silane terminal functions and 1 to 70 parts by weight of an organic polymer (B) miscible at ambient temperature with polymer (A), wherein polymer (B) comprises a polyester, a polyether, a polyurethane, a polyethylenediimine, a polycarbonate, a polyurea, a polyamide, or mixtures thereof.

The Office Action asserts that claims 1–10 are anticipated by or rendered obvious over Comert, because Comert teaches “the mixing of claimed silane polymers with other polymers as required.” Office Action at 2. Applicants respectfully traverse.

As stated in the Manual for Patent Examination Procedure § 2112, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference. *Verdegaal Brothers Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).” MPEP § 2112; *see also SRI Int’l Inc. v. Internet Security Sys. Inc.*, 511 F.3d 1186, 1192, 85 U.S.P.Q.2d 1489, 1493 (Fed. Cir. 2008).

Comert discloses a mixture of an elastomer and a prepolymer forming a composition suitable for making sealants or gaskets. *See* Comert at col. 2, lines 13-24. The moisture-curable oligomeric prepolymer contains an average of two or more functional terminal groups per mole selected from isocyanate and substituted silane groups. *See id.* Examples of suitable elastomers, including polyacrylate, are disclosed in Comert at col. 2, line 49 to col. 3, line 17.

Applicants have amended claim 1 to clarify what is claimed and have removed the recitation of “polyacrylates” from independent claim 1. Accordingly, Applicants respectfully submit that organic polymer (B) of claim 1 is not taught by Comert, and Comert does not anticipate claim 1 or dependent claims 2-15.

Furthermore, Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness because Comert does not teach the subject matter of claim 1, and one of ordinary skill in the art in possession of Comert would not have had reason based on Comert to formulate the presently claimed composition.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. § 2143.03 (citing *In re Royka*, 490 F.2d

981, 180 USPQ 580 (CCPA 1974)). As discussed above, Comert does not teach the organic polymer (B) as claimed, and for at least this reason, Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness.

Moreover, The Supreme Court has held that the obvious analysis “should be made explicit.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (U.S. 2007)(citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). Applicants respectfully submit that the Office Action does not articulate any reason or provide any discussion why the presently claimed invention would have been obvious over Comert. As such, the Office Action necessarily fails to establish a *prima facie* case of obviousness.

Finally, even if Comert were viewed in combination with the knowledge of one of ordinary skill in the art, there is simply no teaching in Comert that would lead one of ordinary skill in the art to the present compositions. As disclosed in the present specification at p. 3, lines 8-12, “[t]he compositions of the invention make it possible to achieve an excellent level of ultimate adhesive strength while still exhibiting the following improved processing characteristics: elevated tack facilitating immediate grab of the two substrates without auxiliary holding means, and maximum open times which are substantially greater than those found in the prior art.” In contrast, Comert teaches elastomeric interpenetrating network compositions that are essentially tack-free (or possess sufficient initial tackiness to be self-adhesive) for use as sealants or gaskets. *See* Comert at col. 1, lines 15-20. Comert does not teach the use of any of the species of claimed organic polymer (B) in its compositions, nor does Comert recognize the problem solved by Applicants or suggest any advantage in using its elastomers is adhesive

compositions as claimed. Accordingly, Applicants submit that the present invention would not have been obvious to one of ordinary skill in the art, and respectfully request withdrawal of the rejection of independent claim 1 and dependent claims 2-10.

**IV. CONCLUSION**

An indication of allowance of all pending claims is respectfully solicited. In the event any issues remain, Applicants would appreciate the courtesy of a telephone call to their counsel to resolve such issues and place all claims in condition for allowance.

Respectfully submitted,

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